

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Claims 1-25 remain in the application;  
Claims 1, 4-20, and 22 have been amended;  
Claims 26 and 27 have been added.

### **Claim informalities**

Claim 22 has been objected to because it informal as to matters of form, with the Examiner citing a deficiency in lines 1-2. Applicant has amended the above-noted claim in accordance with the Examiner's recommendation:

Applicant respectfully submits that the amended claim is no longer informal and respectfully requests that the objection be removed.

### **Claim rejections under 35 U.S.C. § 112**

Claims 4-11 and 14-19 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, with the Examiner listing deficiencies in individual claims and suggesting language that would overcome the rejections.

Applicant respectfully submits that the amended claims are no longer indefinite and respectfully requests that the rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

### **Claim rejections under 35 U.S.C. § 102(e)**

Claims 1-6, 8-10, 12-17, and 19-25 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,741,980 (Langseth).

While it is believed that the above rejection has been rendered moot by Applicants' amendment to the claims at issue, Applicant respectfully disagrees. Langseth shows and discloses a personalized intelligence system in which content is collected from several distributors (data channels) and transmitted to a subscriber. The content that is provided by the distributors is not arranged into discrete products, as claimed.

Moreover, Langseth does not select discrete products from a plurality of custom content media programs and create a subscriber specific package, as claimed. In other words, Langseth is analogous to a "pick and pack" function of a warehouse where standardized parts are removed from shelves and delivered as is. Applicant's claims, on the other hand, are analogous to that of a custom manufacturer, who takes parts that do not stand on their own and who arranges them according to a customer's specification. In addition, Langseth is analogous to having multiple distribution facilities, whereas Applicant's claims are analogous to having multiple manufacturing facilities.

It is respectfully submitted that Langseth does not anticipate Applicant's invention, as currently claimed. Applicant submits that claims 1-6, 8-10, 12-17, and 19-25 are not obvious in view of Langseth and requests that the claims be passed to issue, or in the alternative, reconsidered and/or reexamined.

### **Claim rejections under 35 U.S.C. § 103(a)**

Claim 7 stands rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,741,980 (Langseth) in view of Official Notice, with the Examiner taking the position that:

With regard to claim 7, while the system disclosed by Langseth shows substantial features of the claimed invention (discussed above), it fails to specifically recite that the system has the ability to analyze feedback and retransmit custom content media that fails to be transmitted successfully.

The Examiner takes Office Notice that retransmitting data that fails to be transmitted successfully is old and well known in the art. It is well known that computer networks are not 100% reliable, and failed transmissions may occur for a large number of reasons. Monitoring for feedback such as an acknowledgement packet and retransmitting content which fails to be transmitted successfully would be advantageous since it would have ensured delivery of the content to the subscriber.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to monitor feedback and retransmit custom content media that fails to be transmitted successfully. This would have ensured delivery of the content to the subscriber.

While it is believed that such rejection has been rendered moot by Applicant's amendment of the claims, Applicant respectfully disagrees. "It is well-established that before a conclusion of obviousness may be based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references."<sup>1</sup> Langseth discloses a personalized intelligence system that comprises a plurality of databases that are subscribed to on a regular basis, for example an alert service. If the alert service subscription were updated on an hourly basis, it would not make much sense to provide Langseth's system with a feature that would analyze and retransmit information that would soon be outdated. Moreover, such a provision would cause the system to crash if, for example, the hourly update were not received for 24 hours. In such a case, the system would generate multiples of reminders. It would not be obvious to provide the personalized intelligence system of Langseth with a monitoring feedback, as suggested by the Examiner in the Official Notice, which Applicant specifically traverses. Applicants respectfully requests that the

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<sup>1</sup> Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

Examiner provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

It is respectfully submitted that claim 7, as amended, are not obvious in view of Langseth and the Examiner's Office Notice, and Applicant requests that the claim pass to issue, or in the alternative, reconsidered and/or reexamined.

### **Claim rejections under 35 U.S.C. § 103(a)**

Claims 11 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,741,980 (Langseth) in view of published U.S. Patent Application No. US 2002/0,052,885 (Levy), with the Examiner taking the position that:

With regard to claims 11 and 18, while the system disclosed by Langseth shows substantial features of the claimed invention (discussed above), it fails to disclose that a portion of the custom content media includes embedded information designed to deter file sharing.

Levy teaches a method of deterring sharing of audio files that are distributed via the internet. Levy discloses embedding information in the audio files that prevents indicates whether or not the file is allowed to be shared (Par 41). This would have been an advantageous addition to the system disclosed by Langseth, since Langseth discloses the delivering personalized radio content (Langseth, Col 11, Lines 4-21). This would have prevented users of the system from sharing the received audio files with users who had not paid for them.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include embedded information in the audio files distributed by Langseth to deter file sharing. This would have prevented users of the system form sharing the received audio files with users who had not paid for them.

While it is believed that such rejection has been rendered moot by Applicant's amendment of the claims, Applicant respectfully disagrees. "It is well-established that before a conclusion of obviousness may be based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references."<sup>2</sup> Langseth discloses and claims a "personalized intelligence system" in which a user pays to a plurality of data channels. Levy, on the other hand, discloses a "file sharing" system that uses embedded data to identify files. These two are diametrically opposed concepts. There is no reason to combine the references of Langseth and Levy because Langseth and Levy serve divergent purposes. There is no suggestion to combine Langseth and Levy because Langseth's users would not want to share their personal information with third parties. Levy, on the other hand, wants to share files. Levy does want to have some control over who shares files, but the files of Levy are meant to be shared. There is no expectation of privacy. There is not motivation to combine the references of Langseth and Levy other than the Examiner's assertion that "it would have been "obvious to deter file sharing".

It is respectfully submitted that claims 11 and 18 are not obvious in view of Langseth and Levy and Applicant requests that the claims be passed to issue, or in the alternative, reconsidered and/or reexamined.

## CONCLUSION

On the basis of the foregoing amendments, remarks, and arguments of record, applicant respectfully submits that claims 1-27 are in condition for allowance and Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Alternatively, if the Examiner is of the opinion that prosecution of the application may be expedited by a telephonic interview, the Examiner is invited to contact applicant's representative at the telephone number listed below.

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<sup>2</sup> Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

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**22854**

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